

REMARKS

This application pertains to a novel process for producing a partially self-adhesively treated backing material.

Claims 1, 2 and 4-23 are pending; Claim 3 being canceled by this amendment.

Claim 1 has been amended to more specifically recite that the domes or geometric shapes are deformed sufficiently to cause them to come into contact with and become bound to other domes or geometric shapes. Support for the added limitation can be found at page 4, lines 28-29; page 17, line 36 - page 18, line 4 and in Figure 6. While the exact wording used in the amendment to Claim 1 may not be found in the specification *in haec verba*, those skilled in the art reading the language of the specification, especially the language mentioned above, and considering Figure 6 in comparison to Figure 5, would clearly understand that the deformation of the domes expands them sufficiently to come into contact with and be bound to other domes, as shown in Fig. 6, while at the same time retaining their basic character as individual, discrete shapes. Accordingly, the requirements of 35 U.S.C. 112, first paragraph are present, albeit not *in haec verba*.

Claims 3, 5 and 22 stand rejected under 35 U.S.C. 112, second paragraph, for reasons more specifically discussed in the Office Action. The cancellation of Claim 3 and amendment of claims 5 and 22 are believed to obviate this rejection, and the rejection should now be withdrawn.

Turning now to the art rejection, the Examiner rejects Applicants claims under 35

U.S.C. 102(a) as anticipated by Himmelsbach et. al. EP 0 826 380 A2. This, because the Examiner views both the reference and Applicants' claims as being directed to "deforming" the domes etc.; whether said deformation be accomplished by the calendaring of Himmelsbach or the roll nip of the present application. It is clear, however, that Himmelsbach's calendaring produces "special effects such as high luster, glazing, moire' and embossed effects", as the Examiner indicates at page 4 of the Office Action. It is also clear from Applicants' specification and drawings that Applicants are doing more than just creating "special effects such as high luster, glazing, moire' and embossed effects"; they are deforming the shapes to an extent sufficient to cause at least some of them to contact others.

This is neither taught nor suggested in Himmelsbach, and is certainly not inherent in Himmelsbach. There is, for example, nothing in Himmelsbach that would teach or suggest such an amount of deformation; which is certainly more deformation than would be expected to occur as a result of calendaring to impart "special effects such as high luster, glazing, moire' and embossed effects".

Should the Examiner maintain her position regarding inherency, it is respectfully pointed out that extrinsic evidence must make clear that the element or elements the Examiner regards as inherent is/are *necessarily* present in the subject matter disclosed in the reference, and that the presence of such element(s) therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not

sufficient; instead it must be shown that such property *necessarily inheres* in the thing described in the reference. *Id.*

The rejection of Claims 1-23 under 35 U.S.C. 102(a) as anticipated by Himmelsbach et. al. EP 0 826 380 A2 should accordingly now be withdrawn.

In view of the present amendments and remarks, it is believed that claims 1, 2 and 4-23 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested, and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution record in better condition for appeal.

Respectfully submitted,
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